

## **REMARKS**

This Amendment and the following remarks are intended to fully respond to the Office Action mailed August 9, 2006. In that Office Action, claims 1-6, 8-19, and 21 were examined, and all claims were rejected. Specifically, claims 5 and 21 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention; claims 1-4, 6, 8-19, and 21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hafsteinsson et al. (US PG Pub 20040172484A1); and claim 5 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Hafsteinsson as applied to claim 1 above, in view of Glass (USPN 6,629,128). Reconsideration of these rejections, as they might apply to the original and amended claims in view of these remarks, is respectfully requested.

In this Response, claims 1, 5, 8, 14 and 17 have been amended. Claims 4, 11, 18, and 21 have been canceled. Claims 22-26 have been newly added. Therefore, claims 1-3, 5, 6 8-10, 12-17, 19, and 22-26 remain present for examination.

### **I. Interview Summary**

The undersigned hereby thanks Examiner Qing-Yuan Wu for the interview conducted on October 18, 2006. During the interview, claims 1, 4, and 5 were discussed. Examiner Wu indicated that claim 1 would be potentially allowable if amended to include limitations similar to claims 4 and/or claims 5. Based on the conversation with Examiner Wu, the undersigned faxed a set of proposed claims to Examiner Wu on November 1, 2006. Examiner Wu indicated that the claims appeared to be allowable, subject to a further search.

### **II. Information Disclosure Statement**

An information disclosure statement (IDS) was submitted in this application on October 31, 2006. Applicants respectfully request consideration of the references cited in the IDS.

### **III. Claim Amendments**

In this amendment, claims 1, 5, 8, 14, and 17 are being amended. Specifically, the independent claims (1, 8, and 14) are being amended to incorporate language similar to claim 4, which is being canceled. Based on the communications (described above) with Examiner Wu, Applicants believe that these amendments place all of the claims in condition for allowance. Additionally, Applicants submit that the references cited in the Office Action do not teach or suggest “if the selected adapter does not map to the control, determining if an ancestor of the selected adapter maps to the control; indicating that the adapter set is applicable if an ancestor of the selected adapter maps to the control; if an ancestor of the selected adapter does not map to the control, indicating that the adapter set is not applicable.” However, in the event that the rejections in the Office Action are maintained, Applicants have presented arguments below to address the rejections.

New independent claim 22 is a means-plus function claim similar to originally filed claim 20, but also includes language similar to the amendment made to claims 1, 8, and 14. New dependent claims 23, 24, 25, and 26 include language similar to claims 15, 16, 17, and 19.

### **IV. Claim Rejections - 35 U.S.C. § 112**

Claims 5 and 21 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants respectfully traverse this rejection.

Claim 5 has been amended to clarify that "the selected adapter" refers to the ancestor adapter set. Applicants submit that this amendment addresses the Office Action's rejection, and withdrawal of the rejection of claim 5 is respectfully requested. Claim 21 has been canceled.

### **V. Claim Rejections – 35 U.S.C. § 103**

Claims 1-4, 6, 8-19, and 21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hafsteinsson et al. (US PG Pub 20040172484A1), hereinafter “Hafsteinsson.” Applicants respectfully traverse this rejection.

A. Relevant Legal Authority: Prima Facie Case of Obviousness

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *Manual of Patent Examining Procedure (MPEP)* § 706.02(j) (citing *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)). The Applicants respectfully submit that the Office Action has not met the burden of establishing a *prima facie* case of obviousness, because the Office Action relies on Hafsteinsson to disclose all the elements of the currently pending claims, and the portions of Hafsteinsson relied upon by the Office Action are not prior art. Thus, the Office Action has not established a *prima facie* case of obviousness with respect to any of the pending claims.

B. Relevant Legal Authority: Priority of CIP Patent Applications

As previously described by the Applicants, the present application has a priority date at least as early as August 17, 2000. *See Declaration under 37 C.F.R § 1.131*, filed April 13, 2005. The publication date of Hafsteinsson is September 4, 2004. However, Hafsteinsson, claims priority to a continuation-in-part application (CIP) filed April 4, 2001, which claims priority to Provisional Patent Application No. 60/194,695, filed April 5, 2000, hereinafter "Provisional." Accordingly, for any portions of Hafsteinsson to be prior art as applied to the present application, they must be entitled to the priority date of the Provisional.

As the law in this area makes clear, the parent application provides priority to a CIP, and any of its children, for only the subject matter disclosed in the parent application. The priority date of a parent application can be accorded to a CIP (or child applications of the CIP) for only that material presented in the parent application. *See William Pordy v. Land O'Lakes, Inc.*, 97 Fed. Appx. 921, 929 (Fed. Cir. 2004). If an Office Action "wishes to utilize against an applicant a part of that patent disclosure found in an application filed earlier than the date of the application which became the patent, it must demonstrate that the earlier filed application contains §§120/112 support for the invention claimed in the reference patent." *In re Wertheim*,

646 F.2d 527, 537, 209 USPQ 554(CCPA 1981). Accordingly, we must look to the disclosures in the Provisional to determine whether the portions of Hafsteinsson cited in the Office Action to reject the claims, are reflected in the Provisional and are thus entitled to the priority date of April 5, 2000.

C. Claim Amendments

Independent claims 1, 8 and 14 have been amended to include language similar to claims 4 and 21, which are not cancelled. The Office Action rejects claims 4 and 21 on the same grounds as claim 1 (“this claim is rejected for the same reason as claim one above”). Independent claims 1, 8 and 14 have been amended to recite “if the selected adapter does not map to the control, determining if an ancestor of the selected adapter maps to the control; indicating that the adapter set is applicable if an ancestor of the selected adapter maps to the control; if an ancestor of the selected adapter does not map to the control, indicating that the adapter set is not applicable.” Not only does Hafsteinsson fail to disclose that the conversion rules, which the Office Action equates to an adapter, maps to a control, but there is also no mention of the conversion rules having ancestors. Moreover, as described below, if the Office Action relies on the disclosure of Hafsteinsson regarding use of a device capability, this subject matter is not prior art, because it is not supported by the disclosures of the Provisional. None of the other references cited by the Office Action compensate for the deficiency in Hafsteinsson. Thus, newly amended claims 1, 8, and 14 are patentable. Dependent claims 2, 3, 5, 6, 9, 10, 12-13, 15, 16, 17, and 19 depend upon one of claims 1, 8, and 14 and are allowable for at least the same reasons.

D. Rejection of Claim 1-6 and 8-13

Claims 1 and 8 are independent claims that recite similar limitations. Claim 1 is repeated below as representative of both claims 1 and 8. The particular section of Hafsteinsson, which the Office Action asserts discloses the noted limitation, is included in parenthesis next to the limitation. A careful comparison of the noted sections of Hafsteinsson with the Provisional, makes clear that the Provisional does not provide support for the sections of Hafsteinsson relied upon by the Office Action in rejecting claims 1 and 8.

A computer-implemented method for selecting an adapter to transform information sent from a server object to a device and information sent from the device to the server object, comprising:

determining a capability of the device; (**paragraph [0023], lines 10-13)**

retrieving information about an adapter set based on the capability;  
using the information to determine if the adapter set is applicable to the capability, wherein using the information step, comprises: (**paragraphs [00014-0017])**

selecting each adapter in the adapter set;  
determining if the selected adapter maps to a control identified by the information;

indicating that the adapter set is applicable if the selected adapter maps to the control;

if the selected adapter does not map to the control, determining if an ancestor of the selected adapter maps to the control;

indicating that the adapter set is applicable if an ancestor of the selected adapter maps to the control;

if an ancestor of the selected adapter does not map to the control, indicating that the adapter set is not applicable; and

in response to an indication that the adapter set is applicable, selecting the adapter set, wherein the adapter is selected from the adapter set.

**(paragraph [0017], lines 1-13 and paragraph [0020], lines 7-14)**

**1. The Provisional Does Not Support the Disclosures In Paragraph [0023], Lines 10-13 Of Hafsteinsson**

As described above, the Office Action cites to paragraph [0023], lines 10-13 of Hafsteinsson for the argument that Hafsteinsson discloses “determining a capability of a device.” Specifically, paragraph [0023], lines 10-13 of Hafsteinsson states “[t]he request will generally contain information about the device and browser type and this information, in conjunction with

a database of information about the capabilities of many types of devices, is enough to enable a general and automatic conversion of the intermediate data format into a device specific format.” Accordingly, for this section of Hafsteinsson to be prior art, the Provisional application must provide support for the concept of a request containing information regarding the device and browser type, which may be used to determine the capabilities of the device by looking up the information in a database that includes capabilities of many devices. Applicants kindly submit that the Provisional does not provide support for this concept, nor for determining a capability of a device by any other method.

The Provisional teaches a system where conversion of data is based on conversion rules related to the client request, and not to the specific device or browser type. *See Provisional*, page 3, lines 12-14. The Provisional is clear that the specific conversion or transformation used to convert the data is determined by the client request. *See Id.* at page 3, lines 11-13 and page 6, lines 10-12. The Provisional explains, “a client sends in parameters to the system requesting a certain URL, which contains an HTML document and what transformation to use to transform the HTML.” *Id.* page 6, lines 10-12 (emphasis added). The Provisional further states that to transform the data, “the system checks if a transformation document with the given name exists.” *Id.* page 7, line 26 (emphasis added). There is nothing in the Provisional indicating that a capability of a device is ever determined. Moreover, because the client request already contains the specific transformation to use for conversion of the data, there is no need to determine a capability of the device, much less use the determined capability of a device to retrieve information about an adapter set as is claimed in claim 1.

In addressing this deficiency in the Provisional, the Office Action states that “the request from the device to the system identifies what transformation to use to transform the HTML document, and based on the request, the device capability can be determined [provisional application, page 3, lines 11-16; page 6, lines 10-12].” *Office Action* (8/9/06), page 8. Applicants politely submit that merely because the device capability can be determined does not mean that it is determined.

Indeed, the Office Action’s statement appears to rely on a theory of inherency. Although the inherent disclosures of a reference may be used to show anticipation of a claim, to establish

inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’ MPEP § 2112 (*quoting In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted) (emphasis added)). To establish inherency, “the Office Action must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” MPEP § 2112 (*quoting Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original)). The Office Action has not provided a basis in fact or technical reasoning for why determining a capability of a device necessarily follows from the disclosures of the Provisional. Accordingly, the Office Action cannot rely on inherency for establishing that the Provisional discloses determining a capability of a device.

For all of these reasons, the disclosures in Hafsteinsson relied upon by the Office Action to anticipate the “determining” step of claim 1, are not supported, explicitly or inherently, by the disclosures of the Provisional, and are thus not entitled to the Provisional’s priority date. The Office Action has therefore not established a *prima facie* case of obviousness with respect to claim 1, because he has not established that the “determining” step is taught by the prior art.

## **2. The Provisional Does Not Support the Disclosures In Paragraph [0014-0017] Of Hafsteinsson**

In addressing the “retrieving information” and the “using the information” steps recited in claim 1, the Office Action also relies on disclosures of Hafsteinsson, namely paragraphs [0014-0017]. Specifically, the Office Action states that these paragraphs in Hafsteinsson disclose “the search/selection of selection/conversion rules based on the capabilities of a particular device from databases of conversion rules and based on these conversion rules transforming information to device-specific information suitable for display in a mobile device requesting the information.” *Office Action* (8/8/06), page 4. For these paragraphs of Hafsteinsson to be prior art, the Provisional must provide support for the concept of searching or selecting conversion rules based on capabilities of a particular device. Applicants kindly submit that the Provisional



does not provide support for this subject matter, because the Provisional never discloses that a capability of a device is ever determined.

As is described in detail above, the Provisional teaches a system where conversion of data is based on conversion rules related to the client request, and not to a capability of a specific device or browser type. The Provisional never mentions that conversion rules are selected or searched based on a device capability. Rather, the URL in the client request includes what transformation to use to transform the HTML. *See Provisional*, page 6, lines 10-12. Nor does it make sense in the method taught by the Provisional to determine the capability of a device, because the client already contains the specific transformation to use for conversion of the data.

For these reasons, the disclosures in Hafsteinsson relied upon by the Office Action to support his obviousness arguments for the “retrieving” and “using” steps of claim 1, are not supported by the disclosures of the Provisional, and are thus not entitled to the Provisional’s priority date, i.e. the subject matter is not prior art. For this additional reason, the Office Action has not established a *prima facie* case of obviousness with respect to claim 1.

Claims 2-6 and 9-13 depend upon claims 1 and 8, respectively, and are allowable for the same reasons described above. Moreover, claim 5 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Hafsteinsson as applied to claim 1 above, in view of Glass (USPN 6,629,128), hereinafter “Glass.” In rejecting claim 5, however the Office Action must still rely on the disclosures of Hafsteinsson. As is described in detail above, the portions of Hafsteinsson relied upon by the Office Action are not prior art with respect to the present application. Glass does not compensate for the deficiencies of Hafsteinsson. Accordingly, the Office Action has not established a *prima facie* case of obviousness for rejecting claim 5.

*E.      Rejection of Claims 14-19*

The Office Action rejects claim 14 by stating “Hafsteinsson teaches substantially the method for selecting an adapter to transform information. Therefore Hafsteinsson teaches substantially the system for implementing the method.” Applicants submit that the Office Action's rejection of claim 14 is improper; because the Office Action has not pointed out which sections of Hafsteinsson, or other reference, disclose the specific limitations of claim 14.



Claim 14 recites “a device capabilities component that determines capabilities of the device.” As described in detail above, the disclosures of Hafsteinsson that relate to capabilities of a device are not prior art. For this reason alone, a *prima facie* case of obviousness has not been established with respect to claim 14.

Claim 14 includes additional limitations that are neither taught nor suggested by Hafsteinsson. *Inter alia*, claim 14 requires a device interaction component coupled to a device capabilities component, a receiving component, and a sending component, wherein the device interaction component coordinates communication between the device and an application executing on the server. Hafsteinsson fails to disclose a device interaction component as claimed in claim 14. Specifically, Hafsteinsson does not teach or suggest any component that is coupled to a device capabilities component, a receiving component, and a sending component, and that also coordinates communication between a device and an application executing on a server. Nor has the Office Action cited to any other reference to compensate for this deficiency in Hafsteinsson. For this additional reason, the Office Action has also failed to establish *prima facie* obviousness with respect to claim 14.

## VI. Conclusion

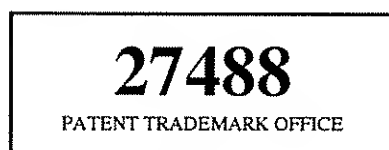
This Amendment fully responds to the Office Action mailed August 9, 2006. Still, that Office Action may contain arguments and rejections that are not directly addressed by this Amendment due to the fact that they are rendered moot in light of the preceding arguments in favor of patentability. Hence, failure of this Amendment to directly address an argument raised in the Office Action should not be taken as an indication that the Applicant believes the argument has merit. Furthermore, the claims of the present application may include other elements, not discussed in this Amendment, which are not shown, taught, or otherwise suggested by the art of record. Accordingly, the preceding arguments in favor of patentability are advanced without prejudice to other bases of patentability.


It is believed that no fees are due with this Amendment. However, the Commissioner is hereby authorized to charge any deficiencies or credit any overpayment with respect to this patent application to deposit account number 13-2725.

In light of the above remarks and amendments, it is believed that the application is now in condition for allowance and such action is respectfully requested. Should any additional issues need to be resolved, the Examiner is requested to telephone the undersigned to attempt to resolve those issues.

Respectfully submitted,

Date: November 9, 2006



  
\_\_\_\_\_  
Rene Pereyra, Reg. No. 45,800  
MERCHANT & GOULD P.C.  
P.O. Box 2903  
Minneapolis, Minnesota 55402-0903  
(303) 357-1637

K:\Clients\40\40062\0255-US-U1\Amend & Resp to 8.09.06 OA.doc